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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,448	02/27/2004	Hiroshi Kido	2/187 PCT	9915
28502 7590 04/16/2007 MICHAEL P. MORRIS BOEHRINGER INGELHEIM CORPORATION 900 RIDGEBURY ROAD P. O. BOX 368 RIDGEFIELD, CT 06877-0368			EXAMINER HAGOPIAN, CASEY SHEA	
			ART UNIT 1615	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/790,448	Applicant(s) KIDO, HIROSHI	
	Examiner Casey Hagopian	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2-27-2004</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Receipt is acknowledged of applicant's Foreign Priority Documents, Oath and ADS filed 8/5/2004.

Claim Objections

Claim 13 is objected to because of the following informalities: the word "therapeutical" appears to be missing a "y". Appropriate correction is required.

Art-based Rejections

Please note that **claims 10 and 11 are composition claims and any intended use recitation such as "for the treatment of an influenza virus infection in a warm-blooded animal" does not alone show patentable distinction.** A recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitra (WO 95/07103 A1). Mitra teaches compositions and methods for providing improved treatment, management or mitigation of cold, cold-like and/or flu symptoms by administering a safe and effective amount of a composition comprising an amino acid salts of propionic acid nonsteroidal anti-inflammatory agent along with at least one of (a) a decongestant, (b) an expectorant, (c) an antihistamine and (d) an antitussive (see Abstract and claim 1). Mitra also names the specific expectorants, "bromhexine and ambroxol, mixtures thereof or pharmaceutically acceptable salts thereof" (see claim 3). Mitra does not explicitly state the particular limitation "for treating an influenza virus infection" found in instant method claims 12 and 13, however Mitra teaches treating, management or mitigation of flu symptoms comprising the same ingredients. It is found that "treating an influenza virus infection" is inherent to Mitra's "treatment, management or mitigation of cold, cold-like and/or flu symptoms" because the method of Mitra and the claimed method are treating the same patient population. Thus, Mitra implicitly teaches the claimed method.

Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nilsen et al. (USPN 5,885,594). Nilsen teaches well-known orally administrable compositions for treating flu symptoms comprising expectorants such as ambroxol and pharmaceutically acceptable salts thereof (see col. 9, line 49 – col. 10, line 14). Nilsen does not explicitly state the particular limitation "for treating an influenza virus infection" found in instant method claims 12 and 13, however Nilsen teaches treating flu symptoms comprising the same ingredients. It is found that "treating an influenza virus

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infection" is inherent to Nilsen's method of treating flu symptoms because the method of Nilsen and the claimed method are treating the same patient population. Thus, Nilsen implicitly teaches the claimed method.

Conclusion

All claims have been rejected; no claims are allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Casey Hagopian whose telephone number is 571-272-6097. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carlos Azpuru, can be reached at 571-272-0588. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Casey Hagopian

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Examiner
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